

1 UNITED STATES DISTRICT COURT  
2 SOUTHERN DISTRICT OF NEW YORK

3 CAN'T STOP PRODUCTIONS, INC.,,

4 Plaintiff,

5 -against-

17 CV 6513 (CS)

6 SIXUVUS, LTD, et al,

7 Defendants.

9  
10 United States Courthouse  
White Plains, New York

11 December 8, 2017

12  
13 B e f o r e:

HONORABLE CATHY SEIBEL,  
District Court Judge

14  
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25

1 THE CLERK: Can't Stop Productions Inc., versus  
2 Sixuvus Limited.

3 THE COURT: Good morning, Mr. Levy.

4 MR. LEVY: Good morning.

5 THE COURT: Ms. Matz and Mr. Adelman.

6 MR. ADELMAN: Good morning, your Honor.

7 MS. MATZ: Good morning.

8 THE COURT: Mr. Caplan and Mr. -- I'm sorry, Clarida?

9 MR. CLARIDA: Clarida. Like Florida.

10 THE COURT: Clarida. Okay.

11 MR. CAPLAN: Good morning, your Honor.

12 THE COURT: Everyone can have a seat.

13 MR. CLARIDA: Good morning.

14 THE COURT: We are here because Karen Willis, doing  
15 business as Harlem West Entertainment, wants to intervene in  
16 this case and wants me to vacate, or at least modify the TRO  
17 that I entered last week.

18 My first concern, Ms. Matz, is that it looks like  
19 your clients have not been abiding by it.

20 MS. MATZ: I'd be happy to address that, your Honor.

21 So as an initial matter, I do think that our clients  
22 have been instructing all of their agents to abide by it. If  
23 you're talking about the Red Entertainment email blast that was  
24 sent out, that's attached to their papers, it's the -- we did  
25 instruct them how to present the name. We have asked them

1 since to issue a correction and they're doing it.

2 THE COURT: Well, I'm looking at Exhibits 6 through 9  
3 of Ms. Willis's affidavit.

4 MS. MATZ: Yes. So my understanding is that these --  
5 the first one, Exhibit 6, isn't dated. Exhibit 7 is, and it's  
6 from December 2nd. Our client's marketing people were told  
7 what to do and they're working on making sure that everything  
8 is in compliance with it.

9 This was the day after the order was issued and they  
10 have been moving everything so that it is Sixxvix presents The  
11 Legendary Village People.

12 THE COURT: All right. Well, here's Exhibit 9 is  
13 from, it looks like December -- looks like it was sent out on  
14 December 7th. And, you know, when there's an order working  
15 toward complying is not complying.

16 Your individual clients on social media don't seem to  
17 be abiding by the ruling. Hash tag real Village People is not  
18 what I said that they could use. They need to understand that  
19 they have to abide by it. They can make arguments in English  
20 sentences. They can say my Village People is more authentic  
21 than some other Village People, but they can't hold themselves  
22 out as anything inconsistent with my ruling.

23 I'm going to modify my ruling anyway, because I do  
24 think it's confusing. But I had the opportunity to go back and  
25 read the transcript from last time, and I looked at a little

1 bit of the case law. I mean, we're in a funny position here.  
2 We have the licensee who's been licensing the trademark for 30  
3 years and paying for it, saying it's invalid; which may or may  
4 not be a position for the licensee estopped from taking. We  
5 have the new licensee, the proposed intervenor, who presumably  
6 is now going to argue that the trademark is valid after  
7 spending years litigating against the plaintiff and trying to  
8 argue that it's invalid.

9 I notice, Mr. Levy, that when we were last here, you  
10 said something that sort of went by me at the time, which was  
11 that Ms. Willis had been litigating with your client for ages  
12 over the validity of the trademark, and she was taking the  
13 position it was invalid, and you said that it had been upheld  
14 repeatedly.

15 First of all, where was that litigation?

16 MR. LEVY: The Trademark Appeals Board, wherever the  
17 trademark office --

18 THE COURT: I'm sorry. Slow down.

19 MR. LEVY: There were four petitions against us at  
20 the trademark office and we had trademark counsel handle it,  
21 but I think it was the trademark appeal -- it's whatever the  
22 primary court is for the trademark office and went through --

23 THE COURT: The TTAB or something?

24 MR. LEVY: TTAB, right.

25 THE COURT: And did Ms. Willis make any of the same

1 arguments on invalidity as the defendants are making here?

2 MR. LEVY: Well, her big argument was that we had a  
3 committed fraud on the trademark office when we renewed, and we  
4 said we were renewing for records, and we put down cassettes  
5 and CDs; she said, well, they don't put down records anymore,  
6 and therefore, for us to say we were renewing it, was a fraud.  
7 That took two years to litigate and we were upheld.

8 The other arguments -- you know, I didn't handle it,  
9 your Honor. I've seen it. There's probably some overlap.

10 THE COURT: All right. Don't guess.

11 MR. LEVY: I could find out from trademark counsel  
12 who litigated it.

13 THE COURT: Maybe, I don't know, Mr. Caplan and  
14 Mr. Clarida, do you know?

15 MR. CAPLAN: We were not her trademark counsel in  
16 those proceedings. I do know that there was an issue about the  
17 trade dress with respect on the motorcycle cop character.  
18 That's the only portion of the other proceedings that I was  
19 ever filled in on.

20 MS. MATZ: Your Honor, if I may.

21 THE COURT: Yes.

22 MS. MATZ: I don't know about all of them. I am  
23 familiar with at least one of the TTAB proceedings because I  
24 reviewed the records. Actually, one of the declarations from  
25 them was attached to our papers, and one of them, the grounds

1 was an abandonment argument, not a naked licensing argument.

2 One of the ways that Ms. Willis had previously  
3 attacked the mark was by saying the plaintiff wasn't using it,  
4 our clients were using it, and that that use didn't count  
5 towards the plaintiff and they had abandoned it under the  
6 statute, which is three years, plus an intend not to resume  
7 use.

8 THE COURT: Well, it is funny because, as I said, the  
9 defendants have been licensing it and they now want to say it's  
10 invalid, at least as between themselves and the plaintiff.

11 Then a party who's been saying it's invalid is now  
12 saying, no, it's invalid and it's licensed to me. Excuse me.  
13 It's valid and it's licensed to me.

14 MR. CAPLAN: Can I interject?

15 THE COURT: That doesn't mean you can't say that, but  
16 it's just funny.

17 MR. CAPLAN: I would just like to make one  
18 interjection, which is, if you've made the claim and the claim  
19 was rejected, then you have to live by the law of the land,  
20 which is, it's valid. So obviously, at the time that Karen  
21 Willis doing business as Harlem West Entertainment entered into  
22 the ten-year trademark licensing agreement in May of 2017, at  
23 that point in time, the prior arguments had been rejected by  
24 the courts and the law of the land was that it's a valid  
25 trademark, so she's going to with the law of the land --

1 THE COURT: She's got to live with it.

2 MR. CAPLAN: Right. Exactly.

3 THE COURT: So I guess her position now is, fine,  
4 it's valid, it belongs to me.

5 And, as I think I said to Mr. Levy, previously, his  
6 clients may have painted themselves into a corner, but  
7 Mr. Levy, do you still have the optimism you had last time you  
8 were here that something could be worked out?

9 MR. LEVY: I do. I would like to just point out, and  
10 it was in my letter to the Court which accompanied my proposed  
11 counter-order, I think one of the arguments that resonated the  
12 most with the Court, that was made by the defendants, was that  
13 we gave one day's notice of termination, and to quote the  
14 Court, that was rotten on our part.

15 But the reality was, and it's in my letter, which is  
16 docketed as Document 34, it's in the court transcript, they  
17 were given six months. We looked at -- in our agreement with  
18 Harlem West, we said, look, we're going to terminate the  
19 agreement, but we're going to give them six months, we're going  
20 to work something out with them. Harlem West wasn't thrilled  
21 with it, but they lived with it. And during that six-month's  
22 period, we made offers.

23 Now, I think it's a little disingenuous towards, at  
24 the end of six months for the defendants to come up and say,  
25 oh, gee, you know, you gave us no notice. We gave them six

1 months to --

2 THE COURT: To wind up.

3 MR. LEVY: To wind up. And now they come in here,  
4 and the cases they cited -- I was at a disadvantage, your  
5 Honor, I was here on a TRO, I hadn't read the cases. I've read  
6 their cases now. At most, at most, under New York Law when you  
7 have an oral agreement where there's no term, at most it can be  
8 one year, otherwise it would run afoul of the statute of  
9 frauds. That would be most. They've had six months already.  
10 So it's not like we were so rotten to them at all. That's one  
11 point there.

12 To answer your question, am I still optimistic? I  
13 think I'm optimistic, because our position, and Mr. Clarida  
14 ignored me when I came in and I said, I feel like Switzerland,  
15 I want to be the neutral party. He said, how can you be  
16 neutral? Your client licensed us.

17 Our position is, they are the exclusive licensees.  
18 Okay? For better or for worse, that's the deal we made, we  
19 honor it. But we can only give the rights that we have, and  
20 our rights are governed by federal law.

21 It would be no different if I sold a house and then  
22 the government came in and said, well, no, half that house was  
23 on a U.S. Army base, you had no right to sell it. Well, all  
24 right. Our trademark is governed by federal law. We gave them  
25 the exclusive right and we'll stand by that, but what do we



1 have the right to give them? I think under the Nominative Fair  
2 Use doctrine which comes out of the Ninth Circuit, but it's  
3 been cited in several courts, a musician, in order to identify  
4 what he did in the past, can make reference to a trademark.

5 So I think the issue is, we can go through all this.  
6 I hope the mediation session works. But afterwards, if it  
7 doesn't, when the Court rules on what the scope of our  
8 trademark is, that's what we gave an exclusive license to them  
9 for. Now, I think that reasonable people can sit there and  
10 say, okay, how can we work this out?

11 I don't think it's reasonable, your Honor, though, to  
12 have the one modifier on the defendant's part being Sixuvus  
13 presents. Because Sixuvus is a limited corporation. Nobody  
14 knows what Sixuvus is. Sixuvus presents. That's like Stewart  
15 Levy presents or Madison Square Garden presents. What does  
16 that mean?

17 If the whole idea is no consumer confusion, that  
18 it's an accurate portrayal, and I think what I suggested in my  
19 letter, I think what Mr. Caplan suggests in his papers as a  
20 name, which is, the Sixuvus presents the two original members  
21 of the legendary band and their new company and new band,  
22 avoids consumer confusion and it would work out.

23 So I'm confident that if we were in a room together,  
24 either with the imprimatur of the grace of the United States  
25 and a Magistrate Judge there, the parties will come to their

1 senses, and if not, at a preliminary injunction hearing you  
2 will decide what our senses should come to. So, yes, I'm  
3 optimistic.

4 MR. CAPLAN: Your Honor, may I speak a moment?

5 THE COURT: Yes, please.

6 MR. CAPLAN: I think the first question that the  
7 Court has to address is whether or not Karen Willis doing  
8 business as Harlem West Entertainment is a necessary  
9 indispensable party.

10 THE COURT: Does anybody dispute that I ought to let  
11 her intervene?

12 MS. MATZ: Your Honor, we do. So there's two things  
13 going on.

14 One is, obviously, we just got these papers. There  
15 is two types of intervention, and depending on whether they  
16 come in as an intervenor as of right or an intervenor  
17 permissively does affect what their allowed to do in this case.

18 It's also unclear to me at this point if they have  
19 standing to assert the claims they trying to assert. Exclusive  
20 licensees do not always have standing to assert trademark  
21 claims, and the agreement that they have -- the exclusive  
22 license agreement does not give them the right to prosecute  
23 infringement, and, in fact, retains ownership rights of the  
24 mark. So whether they have standing is a threshold matter.  
25 There is also a common law claim, and I'll be honest with the

1 Court, I don't know what the answer to that is, whether they  
2 have standing to assert --

3 THE COURT: Well, even if I might ultimately dismiss  
4 their claim, what's before me right now is a preliminary  
5 question of whether I should let them intervene to assert it.  
6 And I don't have to rule on that today, I don't think, but I  
7 think I have to say I think it's likely that I'm going to rule  
8 on it.

9 They certainly have filed a timely application. They  
10 certainly have an interest relating to the property that's the  
11 subject matter of the action.

12 Their interests may be impaired if the defendants  
13 win, and Mr. Levy, to his credit, has been quite candid, that  
14 his interests are not the same as the defendants in at least  
15 one sense, which is that his client is weary and just would  
16 like to make peace and go home, which may not be what  
17 Ms. Willis wants to do.

18 The application to intervene as of right, it may be  
19 that permissive intervention would apply anyway, but at least  
20 for purposes of today, I'm going to allow them to intervene,  
21 subject to whatever future opposition anybody may want to  
22 raise.

23 And the question becomes, what are we going to do  
24 going forward?

25 Is your client -- did you have more you wanted to

1 say, Mr. Caplan?

2 MR. CAPLAN: Yes, I do.

3 THE COURT: Okay.

4 MR. CAPLAN: But thank you for permitting us to  
5 intervene.

6 I would suggest a couple of things. One is, and we  
7 cite it in our brief, what I would call the higher standard  
8 necessary for what I would deem to be a mandatory injunction,  
9 which I believe that the TRO from last Friday is, and we cited  
10 the *Tom Doherty Associates versus Saban* case, a Second Circuit  
11 decision in which the court said: Where preliminary injunction  
12 orders relief that is mandatory and cannot be undone after  
13 trial on merits, movant must meet a heightened standard of  
14 showing a clear and substantial likelihood of success on the  
15 merits and irreparable harm in the absence of injunction.

16 I think, one, those standards were probably not met  
17 last Friday; but, two, if we're allowed to intervene, and we're  
18 deemed to have been an indispensable and necessary party in the  
19 action, I think we needed to have been heard prior to the TRO  
20 being entered, and I know that you didn't have us in front of  
21 you at that point in time. If we are allowed to intervene as  
22 of today, there is no claim that the defendants presently have  
23 directly against my client.

24 THE COURT: You would be intervening as the  
25 plaintiff?

1 MR. CAPLAN: Yes.

2 So until such time as the defendants create some form  
3 of claim against my client, I think any TRO would be  
4 inappropriate of any measure, because the law is clear that you  
5 need to have an underlying pleading against a party and show  
6 irreparable injury with respect to the claims in that  
7 underlying pleading in order to have injunctive relief.

8 So I think as a matter of law, if you allow us to  
9 intervene today, which it sounds like you are allowing us to  
10 intervene, that the TRO should be vacated just for that reason  
11 alone because we are a necessary and indispensable party. The  
12 injunctive relief that was created as of last Friday without us  
13 here has a direct impact upon us.

14 THE COURT: Let me interrupt you for one second.

15 Ms. Matz, if Ms. Willis intervenes as a plaintiff, do  
16 you expect to counterclaim?

17 MS. MATZ: I would imagine that if, ultimately, she's  
18 allow to intervene as a plaintiff, that there would be claims  
19 brought against her.

20 But this is -- so what Mr. Caplan just said is part  
21 of the problem that I see with making this decision today, as  
22 whether it is mandatory or permissive. Because whether it's  
23 mandatory or permissive intervention does allow the Court to  
24 impose restrictions on the intervenor. They can say, you have  
25 to live by the things that have happened in this case thus far.

1           Also, I will just note that, to the extent we're  
2 talking about whether they could have been bound or not by the  
3 prior order, I know that some of the language your Honor had  
4 problems with in the TRO that we had initially proposed that  
5 was actually taken out of the one we ultimately submitted to  
6 the Court after the conference, but I will note that Rule 65  
7 does say that a TRO can bind other people who are in active  
8 concert or participation with anyone who is a party to the  
9 case.

10           THE COURT: Yes, I hear you, but I do think they're  
11 not aligned, really. They're aligned in one sense, which is,  
12 you know, Mr. Levy's agreeing that the trademark is valid, but  
13 his client's interest is just to get all you people to go away.  
14 It's not really the same intensity of interest as Mr. Caplan's  
15 client.

16           And I do think that probably -- you know, this is why  
17 I hate TROs, because you shoot from the hip and you do things,  
18 upon reflection, may not have been so smart, one of which was,  
19 I think by entering an order that, in effect, tied Mr. Caplan's  
20 client's hands without hearing or giving an opportunity to be  
21 heard to that party, there's a due process issue.

22           And I agree that it may make a difference whether the  
23 intervention is permissive or as of right in the long run. So  
24 that's why I said I'm permitting them to intervene, at least  
25 preliminarily, but I think the moment I grant such a motion,

1 there's going to be a counterclaim, and then there will be a  
2 claim that could support a TRO. So what I would like to do  
3 is --

4 MR. CAPLAN: Your Honor, can I suggest one last thing  
5 before you --

6 THE COURT: Yes.

7 MR. CAPLAN: Which is your question about whether  
8 this can be resolved. I think that if we have this  
9 mediation -- I'm not available on January 5th, I have a jury  
10 trial at the end of January in Nashville, Tennessee, and I have  
11 to be in front of a judge in Memphis and that's the date that  
12 was set prior to us being involved in the case. I believe the  
13 following week, the week of January 12th, will work for  
14 everybody. We can coordinate among ourselves.

15 THE COURT: I'm sure Judge Smith will accommodate  
16 you.

17 MR. CAPLAN: Right. And so I'm hopeful that if we  
18 all get into a room that we can work something out, but I think  
19 in the interim, it would be appropriate that the TRO, as  
20 written, is vacated and the status quo is maintained. Okay?

21 The defendants have done what they have sought to do.  
22 The plaintiff did not move for injunctive relief against the  
23 defendants. So the status quo was changed as a result of your  
24 order. And we have looked on the Sixxvus website, and it does  
25 not appear that they have a concert date set during the next 30

1 days. So I would think that vacating the TRO and having some  
2 type of agreement that they're not going to malign my client,  
3 and we're not going to malign them or disparage going either  
4 way, would be an appropriate mechanism to sort of preserve the  
5 status quo through the 12th, have from the mediation session  
6 with the magistrate judge, and if we can't reach resolution,  
7 have an understanding that there's going to have to be some  
8 form of preliminary injunction hearing hanging over everybody's  
9 heads, to give everybody some incentive to try to work  
10 something out the week of the 12th so that we don't have to  
11 take up any more of your time but at least the status quo has  
12 not been changed. Thank you for hearing --

13 THE COURT: Well, I like the part about not taking up  
14 more of my time.

15 Does either party have dates booked between now and  
16 the mediation?

17 MR. ADELMAN: I'm sorry, what?

18 MS. MATZ: Between now and January 18?

19 THE COURT: Or the week of the 12th?

20 MR. ADELMAN: The 12th?

21 THE COURT: Is either party performing?

22 MR. CAPLAN: Yes.

23 MS. MATZ: The defendant isn't -- your Honor, could I  
24 be allowed to respond to a couple of things he just said, if  
25 you don't mind?



1 THE COURT: Yes.

2 MS. MATZ: I appreciate that.

3 I want to point out a couple of things. First of  
4 all, I actually disagree with Mr. Caplan regarding the  
5 mandatory injunction and whether it was a mandatory injunction  
6 or a change of the status quo. I think some of what some of  
7 the papers have glossed over here is that the plaintiff didn't  
8 move for an injunction to stop my clients from doing anything.

9 The fact is they have admitted that our client was  
10 allowed to continue performing and using it. So what we were  
11 asking for was maintaining the status quo. I don't think it  
12 was a mandatory injunction. Even if it was, I still think we  
13 met the standard.

14 I think part of the other problem here, though, is  
15 that after your Honor issued the TRO, Ms. Willis and Mr. Willis  
16 immediately started trying to create confusion and create the  
17 very issues that they're coming to this Court now and  
18 complaining about, which I think is incredibly unfair and  
19 shouldn't be countenanced.

20 You know, the day after your Honor issued the TRO,  
21 Victor Willis started changing some of these advertisements  
22 that had previously billed as the Village People featuring  
23 Victor Willis to starting using the words the Legendary Victor  
24 Willis. The legendary this, the legendary that. And his  
25 clients also have been going on social media and disparaging my

1 clients.

2           So I think part of the problem here is that they're  
3 trying to say -- there's this issue and we're going to be  
4 harmed, but I think that they're creating the very harm that  
5 they're complaining about.

6           We brought some of this additional evidence that's  
7 happened with us. Obviously, it was not in our original  
8 papers, it hadn't happened yet, but if the Court would like to  
9 see any of it, I would be happy to show it to you.

10           THE COURT: Sure.

11           MS. MATZ: We are still amenable to having a  
12 mediation, and we do think that something can and should be  
13 worked out. But in the meantime, there are -- Mr. Willis is  
14 performing and people are saying to our clients that they can't  
15 believe that this is the performance. So their reputation is  
16 going to be damaged unless they are continued to be allowed to  
17 perform.

18           MR. ADELMAN: It's clear from all the fan uploads and  
19 texts and things that are coming out, that everyone is aware  
20 that Victor Willis was performing in Australia, and not our  
21 clients, and unhappy about it, and making it very clear that  
22 they know the difference between our clients and Victor Willis.

23           The name that we picked the last time -- and I asked  
24 your Honor and in actuality, a lot of people know who Sixuvus  
25 is. Sixuvus presents The Legendary Village People provided an

1 opportunity to make a clear break between my client, which is  
2 owned by Sixxvus, and Victor Willis. And we've also brought a  
3 ton of advertising that says, Village People featuring Victor  
4 Willis.

5 He wants people to know that Victor Willis is  
6 performing. That's his whole MO. Hey, I'm back. Me, Victor  
7 Willis. This is my group; Village People featuring the Victor  
8 Willis. That is what is going to stop the confusion.

9 If the Court leaves the name alone but orders the  
10 parties not to interfere with the other, our parties are just  
11 defending themselves. Victor Willis's party is actively  
12 calling our clients fake; actively saying that they're not the  
13 real Village People; actively saying all kinds of things.  
14 Using the word legendary in his name now, which he didn't do  
15 before the Court order. So I think what you said was very  
16 intelligent. We can get something done at the mediation. It's  
17 why we suggested it to Mr. Levy in the first place; that we all  
18 get together and we all said at the last conference, we should  
19 invite Ms. Willis to come so she can be part of this. And the  
20 reason is, you know, but the thing that I think was really  
21 smart of you -- us -- whoever --

22 THE COURT: Keep going with that.

23 MR. ADELMAN: Yeah, I'll keep going on it. Really, I  
24 didn't mean to do that. Which is, there has to be a hammer  
25 hanging over everybody's head; not just our head, or not just

1 the Willis's head, and not just Can't Stop. Everybody has to.  
2 And by leaving the TRO in place, that actually keeps the hammer  
3 on everybody's head.

4 MS. MATZ: May I approach, your Honor?

5 THE COURT: Yes.

6 Last words, Mr. Caplan.

7 Just hand it to my law clerk.

8 MR. CAPLAN: Okay. There is no TRO in place as  
9 against Victor Willis or Harlem West Entertainment, one.

10 Two, the TRO that was created last Friday has not, as  
11 your Honor noted, been followed by the defendants. We have  
12 suggested one of two alternatives. And before you get to  
13 alternatives. They, the defendants, have maligned and  
14 attempted to cause confusion in Australia by saying that the  
15 band that's performing isn't the real Village People.

16 MR. ADELMAN: Your Honor.

17 MR. CAPLAN: We have proposed, we have proposed two  
18 things: One, either vacate the TRO, which we believe is  
19 mandated, because we weren't a party when it was -- at the time  
20 that it was entered, and there's no claim against my client  
21 presently pending upon which to predicate a TRO against our  
22 client;

23 Or, at a minimum, to modify the TRO to make it more  
24 accurate by saying Sixuvus presents Felipe Rose, Alexander  
25 Briley, former original members of The Legendary Village People

1 and Company.

2 And another issue with the order that you had entered  
3 on Friday was you said, in your order, that the Sixxvus should  
4 be 50 percent of the type size of the Village People; but  
5 actually the case law has it the reversed. It's supposed to be  
6 that the branded name of the band should be 50 percent of the  
7 type size of who is presenting the band, because you're doing  
8 it to say, hey, the Sixxvus of us here, and then in much  
9 smaller letters, the size of the band. But you did it actually  
10 the opposite, and the case law supports a different -- I've  
11 done a lot of band breakup cases, and the case law supports the  
12 name of the band to be smaller than the entity that's  
13 presenting that band, if it's going to be allowed at all.

14 THE COURT: All right. Here's what I think should  
15 happen.

16 MR. ADELMAN: Your Honor.

17 THE COURT: Very last words, Mr. Adelman.

18 MR. ADELMAN: Very last words. And I've done a lot  
19 of band cases also, including -- anyway.

20 What Mr. Caplan said is not true. They did not say  
21 we are the real Village People. And he put in his papers,  
22 Exhibit 3. He love our Australian fans, so we want you to know  
23 that we are not the ones performing at the show that's  
24 apparently being advertised for Australia in December. There  
25 is no Alex, no Bill, no Eric, et cetera, on this tour.

1           There's no mention in that post of the words Village  
2 People. I think that's exactly what your Honor said before  
3 that the parties can do. They can say, that's not us.

4           THE COURT: I think part of the issue here is there  
5 is really no such thing as the real Village People. So it's  
6 not as simple as either side would have it.

7           There are clearly some serious fans who are aware of  
8 the difference between the group that Mr. Willis and Ms. Willis  
9 are putting together, and the group represented by Ms. Matz and  
10 Mr. Adelman.

11           There are probably a lot of people who aren't that  
12 familiar with the history and who are confused. I think  
13 that -- I think that the proposed intervenors have a point that  
14 they didn't have a chance to be heard last time, and having  
15 heard them, I'm going to modify the injunction.

16           Their point that there's no claim against them right  
17 now doesn't move me because, at the moment, or very soon after,  
18 they formally intervene, assuming I allow that, there will be a  
19 claim against them. So right now they're here as a preliminary  
20 plaintiff, but they are also a preliminary counterclaim  
21 defendant.

22           It seems to me the best thing to do to clarify the  
23 confusion is to put it all out there, so it seems to me that  
24 both sides should be able to perform under the name the Village  
25 People, with an asterisk, featuring, and then they can feature

1 whoever they want. And if the person they're featuring is a  
2 member of the original Village People from back in the '70s,  
3 they can say that.

4 MR. ADELMAN: Your Honor, could we take out the word  
5 "the"? I think all parties will agree --

6 MS. MATZ: It should be Village People.

7 MR. ADELMAN: It's not part --

8 THE COURT: Oh, I'm sorry. That's right. You told  
9 me that last time. There is no "the."

10 MR. ADELMAN: Thank you, your Honor. Sorry for  
11 interrupting.

12 THE COURT: No, that's all right.

13 So Mr. Caplan's client can perform under the name  
14 Village People, asterisk -- I'll tell you what goes in the  
15 asterisk in a minute -- featuring Victor Willis of the original  
16 Village People, and featuring whoever else they choose to  
17 feature, or not.

18 Ms. Matz and Mr. Adelman's clients can do the same  
19 thing; featuring whoever they want. And if any of those people  
20 they want to feature, if they want to say, Raymond, whoever he  
21 is, of the original Village People, they can do the same.

22 And then what the asterisk is going to tell people is  
23 the following. And I'm open to suggestion on wording. It's  
24 going to say, the trademark, "Village People" is the subject of  
25 litigation. There are two groups performing under the name

1 Village People. And then everybody is going to know, if they  
2 care which one they're going to go see, that they need to  
3 educate themselves.

4 And if either side wants to say featuring not only  
5 Victor Willis of the original Village People but other people,  
6 they can do that. They can only denote somebody as being of  
7 the original Village People if the person was in the band back  
8 in the '70s that did, you know, "YMCA," "Macho Man," all that.

9 As I understand it, there are two such people in  
10 defendant's group.

11 MR. ADELMAN: That's correct.

12 THE COURT: But if you want to feature somebody else  
13 who's not of the first iteration, that's fine, but you just  
14 can't represent that person to have been --

15 MR. ADELMAN: Original.

16 THE COURT: -- original.

17 MR. ADELMAN: One thing about the asterisk, your  
18 Honor.

19 So, as we know, social -- *Twitter*, for instance,  
20 while they've increased their character limit recently, it will  
21 be hard to say anything if we have to put an asterisk and that  
22 whole line on a *Twitter* post.

23 THE COURT: The other thing, if the asterisk is not  
24 practicable, then the content of it has to be in brackets  
25 immediately following the Village People featuring part.



1 And, yes, it takes up a lot of space --

2 MR. ADELMAN: That's fine.

3 THE COURT: -- but that's necessary to avoid the  
4 confusion.

5 The material in the footnote has to be at least  
6 50 percent the size of the material above, and it has to be at  
7 least 12-point type.

8 MR. ADELMAN: Okay.

9 THE COURT: So it's got to be readable.

10 So if you make Village People Featuring Victor Willis  
11 in 12-point type, you can't make the asterisk in 6-point type.  
12 That asterisk also has to be in 12-point type. But if you make  
13 the Village People Featuring Victor Willis in 20-point type,  
14 then you can make the footnote -- in 30-point type, you can  
15 make the footnote in 15-point type.

16 MR. ADELMAN: So then my next question is about,  
17 there are certain social media platforms, such as Facebook and  
18 others, that have specific rules as to how many -- where you  
19 can put things, and how many things, and how to identify it.

20 So can we at least have some -- as long as the  
21 footnote is in 12 points and is somewhere on the same page,  
22 since we're going to have an asterisk --

23 THE COURT: Yes, I don't think it necessarily has to  
24 be immediately below it but it just has to be --

25 MR. ADELMAN: Okay. That makes sense.

1 THE COURT: -- sufficient to direct the reader to the  
2 footnote. You can't bury it in some obscure place.

3 MS. MATZ: That's fine.

4 Can I ask a clarification question?

5 THE COURT: Yes.

6 MS. MATZ: Because we would like to make sure  
7 everyone is doing it correctly.

8 So, for example, on *Twitter*, on our client's *Twitter*  
9 page, we had, you know, Village People featuring whoever they  
10 decide to feature, and I'm talking about the title of the  
11 *Twitter* page, the part that is always visible. And then we  
12 have the asterisk, and then we have the whole disclaimer below  
13 it. In a following tweet where, say, there's a character  
14 limit, would saying, Village People, asterisk, featuring  
15 whoever, and then the message, be sufficient given that the  
16 asterisk refers to what's up on the page visible, or does it  
17 have to be in every single tweet or post? That's, I guess, the  
18 question I'm trying to get clarification on.

19 MR. CAPLAN: Should be in every tweet, I would think.

20 THE COURT: I guess I am not familiar enough with  
21 *Twitter*, but people get --

22 MR. ADELMAN: That's what I was saying before.

23 THE COURT: I happen not to follow anyone.

24 People get tweets in their phones.

25 MR. ADELMAN: Correct.

1 THE COURT: They don't necessarily see the page, they  
2 just see the tweet.

3 MS. MATZ: Okay.

4 THE COURT: So I think it has to go in the tweet.  
5 And, yeah, it's going to take up a lot of room.

6 MR. ADELMAN: Okay.

7 THE COURT: You can --

8 MR. ADELMAN: Your Honor.

9 THE COURT: You'll just have to be more creative.

10 MR. ADELMAN: Okay. One other technical problem --  
11 and I'm sure more are going to come up, but the URLs of the  
12 various social media, are we going to have to go out and buy  
13 Village People featuring whoever it is, or can we just agree to  
14 keep the URLs we have right now and make sure --

15 THE COURT: What are the URLs now?

16 MR. ADELMAN: They're the ones you type in the  
17 address to get the --

18 THE COURT: But what are they?

19 EURBGS: I mean, we just bought one.

20 THE COURT: Official Village People or something?

21 MR. ADELMAN: Yeah, there's Official Village People.  
22 There's the Real Village People. There's -- we just bought one  
23 called Sixuvus Legendary VP.

24 THE COURT: What's your client's, Mr. Caplan?

25 MR. CAPLAN: I'm not sure, your Honor.

1 MS. MATZ: It's in the license --

2 MR. ADELMAN: It's in their license agreement.

3 MS. MATZ: They have the officialvillagepeople.com  
4 website. That's what they have. That's what's in the license.  
5 I'm not sure if all their social media handles.

6 MR. CAPLAN: That hasn't been transferred over.

7 MS. MATZ: Yes, it has.

8 MR. ADELMAN: Your client has it.

9 MS. MATZ: It was attached to our exhibits in the  
10 papers. Our clients --

11 MR. ADELMAN: Your Honor, if I may.

12 I think the most practical thing is until you order  
13 otherwise, that having the URLs we already have in place is not  
14 a violation of the order. We just have to make sure the pages  
15 reflect what your order states.

16 THE COURT: I think that's right. I think it's --  
17 particularly because everybody's hopeful that something could  
18 be worked out, and because the idea is basically just to make  
19 things clear, pending a further hearing, if need be. It seems  
20 like it would be -- I don't think that it's necessary for  
21 either side to change its URLs for now, but planning ahead, you  
22 might want to.

23 MR. CAPLAN: Your Honor.

24 THE COURT: -- at least purchase the --

25 MR. ADELMAN: Yes, your Honor.

1 THE COURT: -- URL that applies to whatever you think  
2 you may work out.

3 MR. ADELMAN: And the reason --

4 THE COURT: As long as, as soon as somebody types  
5 that in, on the first page they will see the information I've  
6 described so they will know that there are two, and they will  
7 be in a position, if the page they've landed on is not the one  
8 they're looking for, to keep looking.

9 MR. ADELMAN: Yes, we appreciate that, your Honor,  
10 because one of the issues is is with Facebook, we each have a  
11 URL that's verified. It's very difficult to verify something.  
12 So I would appreciate that order.

13 MR. CAPLAN: Your Honor.

14 MS. MATZ: Your Honor, I was going to say, can we  
15 also have like maybe 72 hours to implement all of this? Just  
16 because we do have to get ahold of the people that --

17 MR. ADELMAN: Technologically it's --

18 THE COURT: I mean, both sides need to implement it  
19 with all deliberate speed.

20 MS. MATZ: Yes.

21 THE COURT: 72 hours should be the outside.

22 MR. CAPLAN: Your Honor, there are ten tour dates in  
23 Australia between today and, I believe, the 18th of December,  
24 of which there's been significant marketing, advertising and  
25 promotion for.

1 THE COURT: I mean, they can't go back and undo what  
2 they've already done but --

3 MS. MATZ: Your Honor, those dates already say,  
4 Village People Featuring Victor Willis. That was submitted in  
5 our original motion. That's how they were originally billed.

6 MR. CAPLAN: No, but it doesn't have the asterisk is  
7 what I am saying.

8 Can we live with how it's been advertised already?

9 THE COURT: Look, to the extent things are already in  
10 place --

11 MR. CAPLAN: Yes.

12 THE COURT: -- you know, yes. But anything that --

13 MR. CAPLAN: I got that.

14 THE COURT: You know, if there's a commercial that is  
15 set to run tonight in Australia, I don't expect you to change  
16 it, but any new commercial that you buy or any new ad that  
17 appears should have --

18 MR. CAPLAN: A promoter will be involved, so we will  
19 get the word out.

20 MR. ADELMAN: This is one is on his Facebook page so  
21 he does have the ability to change that.

22 THE COURT: Look, some day you may be duking out  
23 damages one way or the other, and anybody who doesn't move  
24 swiftly on this is going to get hammered.

25 So things like Facebook can be changed today. Things

1 like newspaper ad that's already been placed to run on Monday  
2 in an Australia newspaper, you should be able to add the  
3 asterisk, but something that's running tomorrow, you probably  
4 won't be able to.

5 MR. ADELMAN: Very good.

6 THE COURT: I can't really micromanage it much more  
7 than that. I think all sides understand what my expectations  
8 are.

9 MR. CAPLAN: And this is a TRO that you expect to  
10 stay in place until such time as we have the mediation session?

11 THE COURT: That's what I was thinking, if that's all  
12 right with everybody.

13 MR. ADELMAN: That works for us, your Honor.

14 THE COURT: All right. And the parties are also --  
15 they're free to speak the truth, which is, as long as it's  
16 consistent with the footnote. So Victor Willis can say, I'm  
17 the guy who wrote all the songs. I was in the original Village  
18 People. This band features me. I'm great.

19 And the band that Ms. Matz and Mr. Adelman represent  
20 can say, we performed as Village People for 30 years. If  
21 you've seen the Village People in the last 30 years, it's us.  
22 Our production values are awesome. We feature two members of  
23 the original band.

24 What they can't do is disparage one another. They  
25 can't say the other guy's band is fake and they can't say the

1 other guy's band is inferior. They can absolutely make clear  
2 what's good about their band, and if they want to say the  
3 difference between my band and their band is that we're the  
4 ones who have been performing for 30 years. Okay, but let's  
5 stick to the facts.

6 MR. ADELMAN: Would that include -- I assume this  
7 order extends to all parties' agents as well?

8 THE COURT: Yes, it does.

9 MR. ADELMAN: I ask that because an agent on  
10 Mr. Willis's team is calling up promoters of our team.

11 THE COURT: Well, you know, promoters can call up and  
12 say, just so it's clear, I represent the Village People  
13 featuring Victor Willis, who is the guy who wrote all the songs  
14 and the one everybody knows from the '70s, and there's another  
15 group out there and they're different.

16 MR. ADELMAN: I agree, your Honor.

17 THE COURT: That's okay. But the agents --

18 MR. ADELMAN: What they've --

19 THE COURT: Also I'm not purporting to constrain  
20 unrelated third parties. So if fans want to go on Facebook and  
21 say, Victor Willis stinks, and our guys are great --

22 MR. CAPLAN: Or visa versa.

23 THE COURT: Or visa versa. There's nothing I can do  
24 about that. But I think not only is it fair, but I think it's  
25 more likely to lower the temperature and get everybody to a



1 place where they can get to some kind of agreement.

2 It may be one side or the other needs to start  
3 thinking about another name under which they want to perform  
4 going forward.

5 MR. ADELMAN: Your Honor, I agree with healthy  
6 competition. The alleged -- what was allegedly said was, if  
7 you continue to promote this band, we are going to sue you.  
8 That is allegedly what was said.

9 So I just want to lower the temperature also, and as  
10 are far as calling up and saying our band is better than their  
11 band, book us, I think that's healthy.

12 THE COURT: The agents of the parties, their  
13 promoters, their managers, whatever other terms apply in the  
14 business, are bound by this. But third parties are not bound  
15 by it.

16 MR. ADELMAN: Thank you, your Honor.

17 THE COURT: Let's do the same thing we did last time,  
18 Mr. Adelman and Ms. Matz, take the first crack at drafting an  
19 order --

20 MR. ADELMAN: Yes.

21 THE COURT: -- that reflects what I said. Run it by  
22 the other side. If by some miracle you can agree, great. If  
23 you can't agree, send me one submission with everybody's  
24 dueling suggestions and I'll figure out what best captures what  
25 I've ruled on.

1           This process should not be an opportunity to reargue  
2 and tell me why what I've ruled is wrong. It should just be  
3 capturing what I've ruled.

4           MR. ADELMAN: Your Honor.

5           THE COURT: You know, the legal issue that's of most  
6 interest here is the naked licensing argument, and whether the  
7 defendants are estopped or not from making that argument, and  
8 the reasonable notice point, you know, I think the notice  
9 technically was one day, but built into it was a grace period  
10 of six months. So if you don't win on the trademark, and  
11 probably by the time you have your mediation and we have -- if  
12 it fails and we have a PI hearing, the time will have extended,  
13 you know, closer to a year.

14           So as I said, to me the most interesting question  
15 here is the validity of the trademark, and if it's invalid  
16 because it's a naked license, does that mean the defendants get  
17 to keep it, or does that mean anybody can -- it's a  
18 free-for-all and anybody can perform under it.

19           But it seems to me, if it's a valid trademark, the  
20 plaintiff does have a right, subject to reasonable notice,  
21 unless there was an agreement for perpetuity to say, all right,  
22 I'm going to give it to somebody else.

23           So I'm not reaching any conclusions on any of that,  
24 but it's all food for thought.

25           MR. ADELMAN: Your Honor, may I just note on the

1 order?

2 THE COURT: Yes.

3 MR. ADELMAN: Based on your comments today, and the  
4 modification of the order, and the temporary intervening by  
5 Ms. Willis, we'd ask either a reduction of the bond to zero,  
6 since the playing field seems to have been leveled, or that  
7 Ms. Willis put up a similar bond.

8 THE COURT: I'm sorry. Reduce it because why?

9 MR. ADELMAN: Based on your comments, it seems that  
10 the playing field is ostensibly leveled. It doesn't seem to be  
11 any damages --

12 THE COURT: Well, if it turns out that Ms. Willis  
13 prevails and the trademark belongs to her, if your guys perform  
14 under it, she'll have some damages.

15 MR. ADELMAN: And visa versa. That's why I said,  
16 either reduce the bond --

17 THE COURT: Right, but you asked for the TRO, so you  
18 get to put up the bond.

19 MR. CAPLAN: Yeah, I don't think --

20 MR. ADELMAN: Okay. I mean I think it's a mutual.  
21 He asked for a modification or a vacation of the TRO. A  
22 modification would seem to be he's asking for a similar TRO at  
23 this point.

24 THE COURT: No, I think that was his plan B. I think  
25 he wanted me to just vacate it.

1 MR. ADELMAN: Okay. Thank you, your Honor.

2 THE COURT: So I think the bond should just stay in  
3 place.

4 MS. MATZ: Your Honor, I have one question. I'm  
5 sorry to ask, it's just one more clarification.

6 THE COURT: Oh, okay.

7 MS. MATZ: That is, I agree with everything you said  
8 about, you know, positively, we're great, hire us, all that.  
9 The one question I have is that, in the past couple of days,  
10 there have been some performances in Australia. Some fans are  
11 coming onto your clients' Facebook page and saying, that was  
12 terrible, whatever. I know we can't stop third parties. I'm  
13 assuming we are allowed to respond and at least say that was  
14 not our group. This is our performance. Point to *YouTube*  
15 videos of us, whatever it is.

16 THE COURT: That's factual and that's okay.

17 MS. MATZ: Thank you.

18 MR. ADELMAN: Thank you, your Honor.

19 MR. LEVY: Your Honor, just since I sat here quietly,  
20 two seconds.

21 Last Friday you asked me on the naked licensing, if  
22 my client did anything. After the hearing, I spoke to the  
23 client. Not only couldn't they put in new members, but they  
24 had to clear what they were doing with us. We knew exactly  
25 where they were performing. So I just don't want to leave it

1 with we were totally passive.

2 THE COURT: Was that just so they could be sure to  
3 get paid or was that artistic?

4 MR. LEVY: This is artistic. My client co-wrote the  
5 songs and publishes the songs, and he markets it, and he  
6 merchandises it. It has to have a certain caliber, otherwise,  
7 he can't sell his lunchpails and stuff like that.

8 So no, this is a business thing to keep the market  
9 good. If they had somebody who wasn't up to snuff, or didn't  
10 look right, they're not approved. So I just wanted to make  
11 that clear.

12 THE COURT: That may be good for you at the PI  
13 hearing. It may be that I don't have to reach that fascinating  
14 legal issue because maybe you're going to show that you did  
15 police the quality enough so that -- or the defendants will  
16 fail to prove that you didn't police the quality enough for me  
17 to even get to the issue.

18 MR. LEVY: I just wanted it on the record because I'm  
19 sitting here.

20 THE COURT: That's fine.

21 MR. LEVY: I assume we'll write a joint letter to the  
22 magistrate judge asking for an adjournment meantime.

23 THE COURT: Yes. I'm sure she will find a way to  
24 accommodate you. And I don't have anything else in Court  
25 today, so if you want to sit and chat, make yourselves at home.

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MR. CAPLAN: Thank you, your Honor.

(Proceeding concluded)

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Angela A. O'Donnell, RPR, Official Court Reporter, USDC, SDNY